



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,732	03/14/2001	Richard F. Hammen	A-69071/RFT	5501

7590

10/16/2002

FLEHR HOHBACH TEST ALBERITTON & HERBERT LLP
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

EXAMINER

THERKORN, ERNEST G

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 10/16/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

168

Office Action Summary

Application No.

09/808,732

Applicant(s)

1723

Examiner

THIERKORN

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sept 23, 2002
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1723

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092). The claims are considered to read on each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092). However, if a difference exists between the claims and each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092), it would reside in optimizing the elements of each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092). It would have been obvious to optimize the elements of each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092) to enhance separation.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092) as applied to claims 1-6 and 8

Art Unit: 1723

above, and further in view of Snyder, Introduction to Modern Liquid Chromatography, 1979, 276-279. At best, the claim differs from each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092) in reciting use of a capping agent. Snyder, Introduction to Modern Liquid Chromatography, 1979, 276-279 discloses "capping" ensures optimum surface coverage by organic groups. It would have been obvious to cap in either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092) because Snyder, Introduction to Modern Liquid Chromatography, 1979, 276-279 discloses "capping" ensures optimum surface coverage by organic groups.

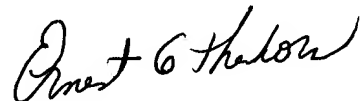
Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092) as applied to claims 1-6 and 8 above, and further in view of Frechet (U.S. Patent No. 5,334,310). At best, the claims differ from each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092) in reciting use of a functional group. Frechet (U.S. Patent No. 5,334,310) (column 7, lines 35-64) discloses that functional groups are essential for ion exchange chromatography, hydrophobic interaction, and reversed phase chromatography and allow use of affinants specific for a single compound. It would have been obvious to use a functional group in either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092) because Frechet (U.S. Patent No. 5,334,310) (column 7, lines 35-64) discloses that functional groups are essential for ion exchange chromatography, hydrophobic interaction, and reversed phase chromatography and allow use of affinants specific for a single compound.

Art Unit: 1723

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Good (U.S. Patent No. 3,808,125) or Fuller (U.S. Patent No. 3,878,092) in view of Frechet (U.S. Patent No. 5,334,310) as applied to claims 9-12 above, and further in view of Larson (U.S. Patent No. 5,723,601). At best, the claims differ from each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092) in view of Frechet (U.S. Patent No. 5,334,310) in reciting use of an enzyme. Larson (U.S. Patent No. 5,723,601) (column 1, lines 25-28, column 2, lines 47-50, column 4, lines 2-16) discloses that enzymes are desirable functional groups for continuous beds. It would have been obvious to use an enzyme in each of Good (U.S. Patent No. 3,808,125) and Fuller (U.S. Patent No. 3,878,092) in view of Frechet (U.S. Patent No. 5,334,310) because Larson (U.S. Patent No. 5,723,601) (column 1, lines 25-28, column 2, lines 47-50, column 4, lines 2-16) discloses that enzymes are desirable functional groups for continuous beds.

The restriction requirement has been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/12
October 15, 2002